



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/709,645	11/13/2000	Richard C. Fuisz	56915-021	3732

7590 11/18/2003

McDermott Will & Emery
Wesley L Strickland
600 13th Street NW
Washington, DC 20005-3096

EXAMINER

EDELMAN, BRADLEY E

ART UNIT	PAPER NUMBER
----------	--------------

2153

DATE MAILED: 11/18/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/709,645

Applicant(s)

FUISZ ET AL.

Examiner

Bradley Edelman

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

This is a first Office action on the merits of this application. Claims 1-19 are presented for examination.

Specification

1. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

The hyperlinks appear on the following pages: p. 2, p. 5, pp. 12-16. Examiner understands the use of hyperlinks is crucial to Applicant's invention. However, according to MPEP § 608.01, embedded URLs cannot appear in the specification. Therefore, they must be deleted or altered so as to comply with MPEP § 608.01.

Claim Rejections - 35 USC § 101

2. Claims 1-17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The invention claimed in claims 1-17 is not related to the technological arts. These claims only describe a method for translating names into Web addresses. They call for a method for receiving a name, selecting a translation formula, and converting the name to an alternate name (which could either be a Web address or an alphanumeric entry). No form of technology is claimed. The entire method could be performed by a human being with a pen and paper, wherein the human writes a name, selects a formula (i.e. name + 2), and then converts the name

into an alternate name (i.e. "www.name2.com," or "2name"). Because the claims do not fall within the technological arts, they are directed to non-statutory subject matter.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. Claims 1-15 all include in the preamble, "a method of translating Web requests." However, the bodies of the claims then fail to describe any Web requests or any steps for translating web requests. Thus, the essential step of translating Web requests is omitted from the claims. Claims 16 and 17 similarly include in the preamble "a method of manufacturing a Web address query." However, the bodies of the claims fail to describe any Web address queries or any steps for manufacturing Web address queries.

4. Claims 1, 14, 15, and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In considering claims 1 and 19, both of these claims include the phrase "a Web address that said is associated with," in the last line of each claim. This phrase is

unclear because it appears to be missing a word. It appears that the word "name" should follow the word "said" in the claim.

In considering claim 14, the phrase "said second translation formula" on line 5 of the claim lacks sufficient antecedent basis. Examiner is unable to understand the meaning of this claim given the lack of sufficient antecedent basis.

In considering claim 15, line 4 of claim 15 includes the phrase, "converting said numeric entry to a second numeric numeric-based Web address." The term "*numeric numeric-based*" Web address is contradictory because a strictly numeric address would consist of only numbers, but a numeric-based address could include additional characters. Thus, it is unclear whether the claim intends for the Web page to be strictly numeric, or instead numeric-based.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 2-7, 9, 10, 12, 13, and 16-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Osaku et al. (U.S. Patent No. 6,061,738, hereinafter "Osaku").

In considering claim 1, as understood, Osaku discloses a method of translating Web requests, comprising the steps of:

Receiving a name associated with a Web address (col. 13, line 25, "888"; col. 14, line 13, "yahoo://olympic");

Selecting a translation formula (col. 13, line 27, "http://www.hatchusa.com/search.p?number=888/"; col. 14, lines 14-15, "http://search.yahoo.com/bin/search?p=olympic/");

Applying said translation formula to said name to result in a scheme-specific name of a Web address that said name is associated with (col. 13, lines 30-35, "the HatchUSA server 258 returns a fully formatted network access command </www.hatch.co.jp/> as the URL 266 corresponding to <888>"; col. 14, lines 25-29, "the database server 284 returns the result of its search of the YAHOO!® database as an HTML encoded document 286 [which will have a URL associated with the initially entered name]").

In considering claim 2, Osaku further discloses receiving a translation identifier ("888", or "yahoo://" as described above), and selecting said translation formula based at least in part on said received translation identifier (i.e. the "888" identifier selects the "hatchusa" translation formula, and the "yahoo://" identifier selects the "yahoo" translation formula).

In considering claim 3, Osaku further discloses that the translation identifier comprises a geographical identifier (col. 18, lines 45-47, wherein the numerical name can be a "zip code").

In considering claim 4, Osaku further discloses analyzing the received name for a translation identifier (inherent, since the identifier is recognized and used to select the formula).

In considering claim 5, Osaku further discloses that the translation formula comprises at least one predetermined character and said step of applying the translation formula includes adding at least one said predetermined character to said received name (i.e. the formula for the "888" name adds the string of characters "http://www.hatchusa.com/search.p?number=" to the received name; col. 13, lines 23-27).

In considering claim 6, Osaku further discloses that the translation formula comprises a string of characters to add to said received name (col. 13, lines 23-27, as described above).

In considering claim 7, Osaku further discloses that applying the translation formula includes adding the string of characters to the received name as a prefix (i.e. "888" becomes "http://www.hatchusa.com/search.p?number=888/"; col. 13, lines 25-27).

In considering claim 9, Osaku further discloses that applying the translation formula includes interleaving the string of characters with the received name (i.e. "yahoo://olympic" becomes "http://search.yahoo.com/bin/search?p=olympic/"; col. 14, lines 12-15).

In considering claim 10, Osaku further discloses that the translation formula removes at least one character from the received name (i.e. the "://" following "yahoo" in "yahoo://olympic" is removed to create "http://search.yahoo.com/bin/search?p=olympic/").

In considering claim 12, Osaku discloses a method of translating Web requests, comprising the steps of:

Receiving a numeric entry of a name associated with a Web address (col. 13, line 25, "888");

Selecting a first translation formula (col. 13, line 27, "http://www.hatchusa.com/search.p?number=888/"); and

Converting said numeric entry to an alphanumeric entry using the first translation formula (col. 13, lines 30-35, "the HatchUSA server 258 returns a fully formatted network access command </www.hatch.co.jp/> as the URL 266 corresponding to <888>").

In considering claim 13, Osaku further discloses receiving a translation identifier ("888"), and selecting said translation formula based at least in part on said received translation identifier (i.e. the "888" identifier selects the "hatchusa" translation formula).

In considering claim 16, Osaku discloses a method of manufacturing a Web address query comprising the steps of:

Receiving a name associated with a Web address (col. 13, line 25, "888"; col. 14, line 13, "yahoo://olympic");

Selecting a translation formula (col. 13, line 27, "http://www.hatchusa.com/search.p?number=888/"; col. 14, lines 14-15, "http://search.yahoo.com/bin/search?p=olympic/"); and

Applying said translation formula to said name to result in a scheme-specific name of a Web address that said name is associated with (col. 13, lines 30-35, "the HatchUSA server 258 returns a fully formatted network access command </www.hatch.co.jp/> as the URL 266 corresponding to <888>"; col. 14, lines 25-29, "the database server 284 returns the result of its search of the YAHOO!® database as an HTML encoded document 286 [which will have a URL associated with the initially entered name]").

In considering claim 17, Osaku discloses a method of manufacturing a Web address query comprising the steps of:

Receiving a numeric entry of a name associated with a Web address (col. 13, line 25, "888");

Selecting a first translation formula (col. 13, line 27, "http://www.hatchusa.com/search.p?number=888/"); and

Converting said numeric entry to an alphanumeric entry using the first translation formula (col. 13, lines 30-35, "the HatchUSA server 258 returns a fully formatted network access command </www.hatch.co.jp/> as the URL 266 corresponding to <888>").

In considering claim 18, Osaku discloses an apparatus for translating a Web address, comprising:

A computer comprising an input device (col. 5, lines 37-46, "input device 14," "computer");

A Web browser operationally installed on said computer (col. 10, lines 20-25, "browser");

A translation module configured to:

Receive a name associated with a Web address from the input device (col. 10, lines 20-50, describing the browser for entering the simplified network address; col. 13, line 25, "888"; col. 14, line 13, "yahoo://olympic");

Select a translation formula (col. 13, line 27, "http://www.hatchusa.com/search.p?number=888/"; col. 14, lines 14-15, "http://search.yahoo.com/bin/search?p=olympic/");

Apply said translation formula to said name to result in a scheme-specific name of a Web address that said name is associated with (col. 13, lines 30-35, "the HatchUSA server 258 returns a fully formatted network access command </www.hatch.co.jp/> as the URL 266 corresponding to <888>"; col. 14, lines 25-29, "the database server 284 returns the result of its search of the YAHOO!® database as an HTML encoded document 286 [which will have a URL associated with the initially entered name]"); and

Process the scheme-specific name through the Web browser (col. 10, lines 40-50).

In considering claim 19, as understood, Osaku discloses a computer readable medium ("server") bearing instructions for translating a Web request, the instructions being arranged to cause one or more processors upon execution thereof to perform the steps of:

Receiving a name associated with a Web address (col. 13, line 25, "888"; col. 14, line 13, "yahoo://olympic");

Selecting a translation formula (col. 13, line 27, "http://www.hatchusa.com/search.p?number=888/"; col. 14, lines 14-15, "http://search.yahoo.com/bin/search?p=olympic/");

Applying said translation formula to said name to result in a scheme-specific name of a Web address that said name is associated with (col. 13, lines 30-35, "the HatchUSA server 258 returns a fully formatted network access command

</www.hatch.co.jp/> as the URL 266 corresponding to <888>"; col. 14, lines 25-29, "the database server 284 returns the result of its search of the YAHOO!® database as an HTML encoded document 286 [which will have a URL associated with the initially entered name]").

6. Claims 1, 2, 4-7, 16, 18, and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Buchholz et al. (U.S. Patent No. 5,956,490, hereinafter "Buchholz").

In considering claim 1, as understood, Buchholz discloses a method of translating Web requests, comprising the steps of:

Receiving a name associated with a Web address (col. 4, line 15, "compressed URI");

Selecting a translation formula, and applying said translation formula ("compression technique") to said name to result in a scheme-specific name of a Web address that said name is associated with (col. 4, lines 26-30, "decompressing by the server, the compressed URI using the compression technique indicated in the subsequent request").

In considering claim 2, Buchholz further discloses receiving a translation identifier, and selecting said translation formula based at least in part on said received translation identifier (col. 4, lines 26-30; col. 3, lines 45-53, where the indication of the compression technique is implemented via a URI compress indicator, "81", "82", or "85").

In considering claim 4, Buchholz further discloses analyzing the received name for a translation identifier (inherent, since the identifier is recognized and used to select the formula).

In considering claim 5, Buchholz further discloses that the translation formula comprises at least one predetermined character and said step of applying the translation formula includes adding at least one said predetermined character to said received name (i.e. the identifier "85" will be appended to the requested compressed URI (Fig. 4, "Request 410").

In considering claim 6, Buchholz further discloses that the translation formula comprises a string of characters to add to said received name (i.e. "85" as described above).

In considering claim 7, Buchholz further discloses that applying the translation formula includes adding the string of characters to the received name as a prefix (Fig. 4, wherein the "85" is appended as a prefix to the compressed URI).

In considering claim 16, Buchholz discloses a method of manufacturing a Web address query comprising the steps of:

Receiving a name associated with a Web address (col. 4, line 15, "compressed URI");

Selecting a translation formula, and applying said translation formula ("compression technique") to said name to result in a scheme-specific name of a Web address that said name is associated with (col. 4, lines 26-30, "decompressing by the server, the compressed URI using the compression technique indicated in the subsequent request").

In considering claim 18, Buchholz discloses an apparatus for translating a Web address, comprising:

A computer comprising an input device ("client"; col. 4, line 5);

A Web browser operationally installed on said computer (col. 4, lines 5-8, wherein a browser is inherent in a system for making Web requests);

A translation module configured to:

Receive a name associated with a Web address from the input device (col. 4, line 15, "compressed URI");

Select a translation formula, and apply said translation formula to said name to result in a scheme-specific name of a Web address that said name is associated with (col. 4, lines 26-30, "decompressing by the server, the compressed URI using the compression technique indicated in the subsequent request"); and

Process the scheme-specific name through the Web browser (col. 26-30).

In considering claim 19, as understood, Buchholz discloses a computer readable medium ("server") bearing instructions for translating a Web request, the instructions being arranged to cause one or more processors upon execution thereof to perform the steps of:

Receiving a name associated with a Web address (col. 4, line 15, "compressed URI");

Selecting a translation formula, and applying said translation formula ("compression technique") to said name to result in a scheme-specific name of a Web address that said name is associated with (col. 4, lines 26-30, "decompressing by the server, the compressed URI using the compression technique indicated in the subsequent request").

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 11 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osaku, in view of Wang et al. (U.S. Patent Application Publication No. 2002/0042736, hereinafter "Wang").

Note: Examiner has interpreted the term “numeric numeric-based” Web address in claim 15 as meaning that the address consists of only numbers (i.e. similar to an IP address), and no additional characters.

In considering claim 15, as understood, Osaku discloses a method of translating Web requests comprising the steps of:

Receiving a numeric entry of a name associated with a first Web address (col. 13, line 25, “888”);

Selecting a translation formula (col. 13, line 27, “http://www.hatchusa.com/search.p?number=888/”); and

Converting said numeric entry to an associated Web address using the translation formula (col. 13, lines 30-35, “the HatchUSA server 258 returns a fully formatted network access command </www.hatch.co.jp/> as the URL 266 corresponding to <888>”).

However, Osaku does not disclose that the associated Web address is a numeric Web address. Nonetheless, converting a numerical entry directly into a numerical, IP address is well known, as evidenced by Wang. In a similar art, Wang discloses a system for converting numbers entered either via bar-code readers or via a keyboard, directly into IP addresses, so that a user does not have to enter a long textual URL in order to access a desired site (Abstract, ¶¶ 0030, 0031, 0034, “direct translation of an IP address inherent in the UPC product information; see also, Fig. 5). Therefore, given the teaching of Wang, a person having ordinary skill in the art would have readily recognized the desirability and advantages of allowing the translation system taught by

Osaku convert the entered numerical names directly into numerical IP addresses, to allow for "immediate and automated access" to the desired web site (see Wang, Abstract). Therefore, it would have been obvious for the system taught by Osaku to convert numerical names into a numeric Web address, as taught by Wang.

In considering claim 11, claim 11 provides a similar limitation as claim 15, requiring that the associated Web address is a "numeric entry." Thus, claim 11 is rejected for the same reasons stated with respect to claim 15.

8. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Buchholz.

In considering claim 8, the claim requires that the step of applying the translation formula includes adding the string of characters to the received name as a suffix. Buchholz does not disclose attachment as a suffix, but describes adding the string of characters as a prefix (col. 3, lines 5-25; Fig. 4, "Request 410"). Nonetheless, the selection of a prefix versus a suffix in the system taught by Buchholz is merely a matter of preference. Buchholz discloses that the received name ("Request URI") has a space before it and a space after it (col. 3, lines 3-5, "in the prior art the Request-URI is delimited by a SP (space) after GET and before HTTP/1.0" – i.e. both before and after the URI). Buchholz then elects to place the identifier in the space before the URI, thus constituting a prefix, for the reasons stated on col. 3, lines 7-25. However, this selection was simply a matter of convenience. Because there is also a space after the URI, a person having ordinary skill in the art would have readily recognized that the identifier

could also go in the space after the URI, to avoid additional packet processing between receipt of the "GET" bits and receipt of the URI. Thus, it would have been obvious to add the string of characters to the received name as a suffix in the system taught by Buchholz.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley Edelman whose telephone number is (703) 306-3041. The examiner can normally be reached on Monday to Friday from 10:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on (703) 305-4792. The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

For all correspondences: (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Bradley Edelman

BE
November 14, 2003